

TOWNSEND and TOWNSEND and CREW LLP

By : /Janet L. Newmaker/
Janet L. Newmaker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Charles Whitaker et al.

Application No.: 10/675,929

Filed: September 29, 2003

For: Systems And Methods For
Verifying Medical Insurance
Coverage

Customer No.: 20350

Confirmation No.: 2374

Examiner: Kristine K. Rapillo

Art Unit: 3626

APPELLANTS' BRIEF
UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the "Notice Of Appeal" and "Pre-Appeal Brief Request For Review" filed April 29, 2008, and the "Notice Of Panel Decision From Pre-Appeal Brief Review" mailed May 14, 2008, for the above-referenced application, Appellants submit this Brief on Appeal.

1. Real Party In Interest

First Data Corporation of Greenwood Village, Colorado, is the real party in interest as the assignee of the above-identified application.

2. Related Appeals And Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status Of Claims

Claims 1-27 are currently pending in the application. All pending claims stand finally rejected pursuant to a final Office Action mailed January 29, 2008. The rejection of claims 1-27 is believed to be improper and is the subject of this appeal. The claims as rejected are attached as Appendix A.

Claims 1-9, 11, 12, 14-16, 22-25 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,012,035 to Freeman, Jr. et al. (“Freeman”) in view of the cited portions of U.S. Patent No. 4,491,725 to Pritchard (“Pritchard”).

Claims 10, 13, 19, 20 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Pritchard as applied to claims 1 and 11, and further in view of the cited portions of U.S. Patent No. 5,070,452 to Doyle, Jr. et al. (“Doyle”).

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pritchard in view of Doyle.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Pritchard and Doyle as applied to claim 20, and further in view of the cited portions of U.S. Patent No. 6,108,641 to Kenna et al. (“Kenna”).

4. Status Of Amendments

The claims have not been amended in this case. This Appeal Brief is filed in response to the final Office Action.

5. Summary Of Claimed Subject Matter

In the following summary, the Appellants have provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support

for other exemplary embodiments encompassed by the claimed subject matter. Thus, it should be appreciated that the references are intended to be illustrative in nature only.

Claim 1 recites a method of verifying insurance coverage shown generally at Fig. 3. The method includes receiving at a financial transaction processing computer system (Fig. 102, ref. no. 102) a member identifier relating to the member (block 304, Fig. 3, ¶¶[0017], [0028] and [0036]). The method also includes searching a database (110) to determine if the member identifier is valid (blocks 306 and 308, Fig. 3, ¶¶[0037] and [0038]). The method then includes transmitting from the financial transaction processing computer system authorization information (block 314, Fig. 3, ¶[0041]).

Claim 2 claims that the financial transaction processing computer system comprises a credit card processing system (ref. no. 102, Fig. 1, ¶[0021]).

Claim 3 claims that the member identifier is received in credit card number format (block 304, Fig. 3, ¶¶[0017] and [0036]).

Claim 5 recites that the individual code is received in a format relating to currency (¶[0036]).

Claim 11 recites a method of verifying insurance coverage relating to a member shown generally at Fig. 3. The method includes entering member identifier information into a credit card processing device (block 304, Fig. 3, ¶[0035]). The method also includes transmitting the information to a host computer system (¶[0036]) and receiving authorization information at the processing device indicating whether the member has insurance coverage (¶[0041]).

Claim 12 recites that the identifier information comprises an individual code in a currency field (¶¶[0017], [0036] and [0037]).

Claim 17 recites an insurance card shown generally in Fig. 2. The card includes an account number in credit card number format (206), a machine-readable storage medium (212), and a list of covered members (216). The insurance card comprises credit card stock ([0033] and [0034]).

Claim 19 recites a method of enrolling a member into medical coverage shown generally at Fig. 4. The method includes receiving enrollment information from the member (block 402, [0042]), assigning an account to the member, wherein the account is in credit card format ([0044]), assigning a code to each covered dependent of the member, wherein each dependent's code is in currency format ([0034]), and producing a card for the member (block 406), wherein the card comprises credit card stock ([0033] and [0034]).

According to claim 20, the method also includes producing dependent codes on the card (Fig. 2).

Claim 22 recites a system for processing insurance information shown generally at Fig. 1. The system includes a credit card processing network ([0016]) and a host computer system (102). The host computer system is programmed to receive insurance information from a point-of-sale device (106) via the credit card processing network and verify coverage ([0016]-[0019]).

6. Grounds Of Rejection To Be Reviewed On Appeal

Issue 1: Whether claims 1-9, 11, 12, 14-16, 22-25 and 27 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,012,035 to Freeman, Jr. et al. ("Freeman") in view of the cited portions of U.S. Patent No. 4,491,725 to Pritchard ("Pritchard").

Issue 2: Whether claims 10, 13, 19, 20 and 26 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Pritchard as applied to claims 1 and 11, and further in view of the cited portions of U.S. Patent No. 5,070,452 to Doyle, Jr. et al. ("Doyle").

Issue 3: Whether claims 17 and 18 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Pritchard in view of Doyle.

7. Argument

Issue 1: Whether claims 1-9, 11, 12, 14-16, 22-25 and 27 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,012,035 to Freeman, Jr. et al. (“Freeman”) in view of the cited portions of U.S. Patent No. 4,491,725 to Pritchard (“Pritchard”).

The Appellants maintain that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper because the record has not established a *prima facie* case of obviousness. Specifically, the record has not properly followed the Graham factors to arrive at a showing that all claim elements exist in the prior art and has not established the relevant skill necessary to determine that it would have been obvious to combine the elements. Moreover, the record is devoid of “clear articulation of the reasons(s) why the claimed invention would have been obvious,” the “key to supporting any rejection under 35 U.S.C. 103,” according to MPEP 2141.

Herein, the Appellants specifically discuss the differences between the prior art and the claimed invention. Based on these differences, the failure of the record to address the level of skill of one in the relevant art, and the absence of the necessary “clear articulation” of the reasoning behind the rejections, the Appellants urge that the case should be moved to allowance.

Claim 1 recites:

A method of verifying insurance coverage relating to a member,
comprising:

receiving at a financial transaction processing computer system a
member identifier relating to the member;

searching a database to determine if the member identifier is valid;

and

transmitting from the financial transaction processing computer
system authorization information.

The cited references do not teach or suggest “receiving at a financial transaction processing computer system a member identifier relating to the member” nor do they teach “transmitting from the financial transaction processing computer system authorization information.” Neither Freeman nor Pritchard teach or suggest a computer that processes financial transactions being used to verify medical insurance coverage. Claim 1 is, therefore, believed to be allowable, at least for this reason.

The Advisory Action cites col. 7, ll. 20-27, and col. 2, ll. 26-49, of Freeman, among others, for this teaching. At the cited locations, Freeman teaches various steps in verifying medical insurance coverage and processing claims. Nowhere does Freeman teach that a financial transaction processing computer is used to accomplish any of this. In fact, the Advisory Action includes the statement, “the invention disclosure by Freeman is interpreted by the Examiner as a financial transaction processing computer in that it . . . authorizes the transfer of funds which reads on financial transaction processing computer.” This is an improper interpretation. Authorizing the transfer of funds and processing financial transactions are not the same.

In an attempt to cure this, the Advisory Action points to the central brokerage computer of Pritchard as being a financial transaction processing computer. The language of Pritchard describing this function makes it clear that the central brokerage computer of Pritchard does not actually process the transaction as the Applicants claim (see, col. 9, ll. 42-49, “But, if the insurance claim assignment provision is invoked by the patient for payment directly to the service provider 16, the insurance carrier, such as 36, can effect an electronic funds transfer by means of a communication to either a bank 40, which serves the service provider 16, or to the institution 42, which has an account for the service provider 16.”) Taken as a whole, it is clear that Pritchard does not, in fact, teach a financial transaction processing computer but, instead, teaches an information management computer that may notify the various parties how funds should be transferred. Hence, the rejection of claim 1 is believed to be improper.

Claim 2 depends from claim 1 and recites that the financial transaction processing computer is a credit card processing system. The cited references do not teach or suggest “wherein the financial transaction processing computer system comprises a credit card processing system.” The Office Action cites Freeman for this teaching. At the cited location, however, Freeman refers to swiping a patent ID card through a “credit card type machine.” Note that this would be a reference to the provider-side system, not the financial transaction processing computer. This teaching fails, however, to inform one skilled in the art that the “financial transaction processing computer system” (i.e., the terminal on the receiving end of the network) is a credit card processing system. “Credit card type machine(s)” may be configured to dial a variety of systems. It is improper to credit this to teaching that such a machine at a doctor’s office contacts a credit card processing system to verify medical insurance coverage. This is a teaching unique to the Appellants’ claimed invention. Hence, the rejection of claim 2 is believed to be improper, at least for this additional reason.

The rejection of claim 3 is believed to be improper for the additional reason that the cited references do not teach or suggest “wherein the member identifier is received in credit card number format.” The Office Action cites Pritchard for this teaching, but nowhere does Pritchard teach or suggest that the identifier is received in credit card number format, and the record has provided no clear explanation for why it would be obvious to one skilled in the art to modify the prior art accordingly. For at least this additional reason, the rejection of claim 3 is believed to be improper.

Similarly, the rejection of claim 5 is believed to be improper for the additional reason that the cited references do not teach or suggest that the “individual code is received in a format relating to currency.” The Office Action states that the Examiner interprets the code in currency format to represent a symbol which, according to the reasoning of the Office Action, may be replaced “without changing the scope of the invention.” The Applicants are unable to find rational for this rejection in the guidelines. It appears that the Office Action is stating that Freeman, in fact, does not teach or suggest the element, in which case, the rejection is invalid. Hence, the rejection of claim 5 is believed to be improper.

Independent claim 11 recites:

A method of verifying insurance coverage relating to a member,
comprising:
entering member identifier information into a credit card processing
device;
transmitting the information to a host computer system; and
receiving authorization information at the processing device
indicating whether the member has insurance coverage.

The element “entering member information into a credit card processing device” is not taught or suggested by the cited references. The credit card type machine, cited by the Office Action from Freeman, is not a credit card processing device. Hence, the rejection of claim 11 is improper.

Claim 12 depended from claim 11 and is believed to be allowable for additional reasons similar to claim 5. Claim 12 recites “wherein the identifier information comprises an individual code in a currency field,” which is similar to claim 5. In fact, the record states that claim 5 is rejected based on the same rational as the rejection of claim 5. In contrast to claim 5, however, the “identifier information” is in a “currency field,” thereby further distinguishing claim 12 from the cited references. Recall that in rejecting claim 5, the Examiner stated an interpretation that in currency format meant using symbols. This hardly applies to the information being in a currency field. Hence, the rejection of claim 12 is unfounded.

The rejection of independent claim 22 is believed to be improper because the cited references do not teach or suggest a host computer system that is “programmed to receive insurance information from a point-of-sale device via the credit card processing network and verify coverage.” The Office Action does not specifically address the use of a credit card processing network through which insurance information is received. More importantly, the prior art does not teach or suggest this. Hence, claim 22 is believed to be allowable, at least for this additional reason.

Issue 2: Whether claims 10, 13, 19, 20 and 26 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Pritchard as applied to claims 1 and 11, and further in view of the cited portions of U.S. Patent No. 5,070,452 to Doyle, Jr. et al. (“Doyle”).

The rejection of independent claim 19 is believed to be improper because the cited references do not teach or suggest all of the claim elements. Claim 19 recites:

A method of enrolling a member into medical coverage, comprising:
receiving enrollment information from the member;
assigning an account to the member, wherein the account is in credit card format;
assigning a code to each covered dependent of the member, wherein each dependent’s code is in currency format; and
producing a card for the member, wherein the card comprises credit card stock.

Regarding “assigning codes to covered dependents that are in currency format,” the Examiner credits this teaching to Doyle without giving patentable weight to the currency format element. This is improper. Using currency format allows a credit card processing network to be used to receive dependent information. The element has independent utility and a rejection that fails to give this element patentable weight is improper.

Claim 20 depends from claim 19 and recites placing the dependent codes on the card, thereby further distinguishing claim 20 from the cited references. Claim 21 also depends from claim 19 and is believed to be allowable, at least for the reasons stated above.

Issue 3: Whether claims 17 and 18 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Pritchard in view of Doyle.

The rejection of claim 17 is believed to be improper because the cited references do not teach or suggest an insurance card having “an account number in credit card format” and “a list of covered members.” Pritchard is cited for the credit card number format, but does not address the format of the number being credit card format, even though the card may be like a credit card. In fact, Pritchard depicts (Fig. 2, ref no. 18) a number NOT in credit card format. Hence, Pritchard appears to teach away from the invention. Doyle is cited for the list of covered members, but Doyle does not teach or suggest that the list is actually on the credit card as the claim recites. Hence, claim 17 is believed to be allowable, at least for this additional reason. Claim 18 depends from claim 17 and is believed to be allowable, at least for the reason stated above.

8. Conclusion

For these reasons, it is respectfully submitted that the rejections should be reversed.

Respectfully submitted,

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/Irvin E. Branch/

Irvin E. Branch

Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP

Two Embarcadero Center, Eighth Floor

San Francisco, CA 94111-3834

Tel: 303-571-4000

Fax: 415-576-0300

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9. Claims Appendix

1. (Original) A method of verifying insurance coverage relating to a member, comprising:
 - receiving at a financial transaction processing computer system a member identifier relating to the member;
 - searching a database to determine if the member identifier is valid; and
 - transmitting from the financial transaction processing computer system authorization information.
2. (Original) The method of claim 1, wherein the financial transaction processing computer system comprises a credit card processing system.
3. (Original) The method of claim 1, wherein the member identifier is received in credit card number format.
4. (Original) The method of claim 1, further comprising receiving an individual code at the financial transaction processing computer system.
5. (Original) The method of claim 4, wherein the individual code is received in a format relating to currency.
6. (Original) The method of claim 1, wherein the insurance coverage relates to medical insurance.
7. (Original) The method of claim 1, further comprising receiving at the financial transaction processing computer system an identifier relating to a provider.
8. (Original) The method of claim 1, further comprising determining whether the provider is a network provider.
9. (Original) The method of claim 1, wherein the authorization information indicates a denial of coverage.

10. (Original) The method of claim 1, wherein the authorization information comprises a co-payment.
11. (Original) A method of verifying insurance coverage relating to a member, comprising:
 - entering member identifier information into a credit card processing device;
 - transmitting the information to a host computer system; and
 - receiving authorization information at the processing device indicating whether the member has insurance coverage.
12. (Original) The method of claim 11, wherein the identifier information comprises an individual code in a currency field.
13. (Original) The method of claim 11, wherein the authorization information comprises a co-payment.
14. (Original) The method of claim 11, wherein the authorization information indicates a denial of coverage.
15. (Original) The method of claim 11, wherein entering member identifier information comprises swiping an insurance card.
16. (Original) The method of claim 15, wherein the insurance card comprises credit card stock.

17. (Original) An insurance card, comprising:
an account number in credit card number format;
a machine-readable storage medium; and
a list of covered members;
wherein the insurance card comprises credit card stock.
18. (Original) The insurance card of claim 17, wherein the insurance card relates to medical insurance.
19. (Original) A method of enrolling a member into medical coverage, comprising:
receiving enrollment information from the member;
assigning an account to the member, wherein the account is in credit card format;
assigning a code to each covered dependent of the member, wherein each dependent's code is in currency format; and
producing a card for the member, wherein the card comprises credit card stock.
20. (Original) The method of claim 19, further comprising producing dependent codes on the card.
21. (Original) The method of claim 19, further comprising entering pre-tax spending account information relating to the member.
22. (Original) A system for processing insurance information, comprising:
a credit card processing network; and
a host computer system;
wherein the host computer system is programmed to receive insurance information from a point-of-sale device via the credit card processing network and verify coverage.
23. (Original) The system of claim 22, wherein the host computer system is further programmed to determine a dependent's coverage.

24. (Original) The system of claim 22, wherein the host computer system is further programmed to determine if a provider is a network provider.

25. (Original) The system of claim 22, wherein the host computer system is further programmed to transmit an approval code.

26. (Original) The system of claim 25, wherein the approval code comprises a co-payment.

27. (Original) The system of claim 25, wherein the approval code comprises a denial of coverage.

10. Evidence Appendix

No additional evidence is provided.

11. Related Proceedings Appendix

No additional proceedings are in process.